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10/691,263

10/22/2003

D. Mark Tucker

2003-12 US

5444

7590
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02/24/2009

EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

02/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/691,263 | Applicant(s) TUCKER, D. MARK | |
| | Examiner PRADEEP C. BATTULA | Art Unit 3725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the reply filed on November 5, 2008

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With respect to the release layer in the frame area being capable of easy removal and facilitate insertion of a document into said pouch area, Kelly shows this when the release is originally separated as seen in Figure 6. With respect to allowing subsequent sealing off of said pouch area by removal of the remainder of said release layer, the Examiner is not completely sure of what is being claimed as the removal of the remainder of the release does not have an effect on the sealing since the sealing is done with the remainder of release attached (Figure 4B of Application). It is seen that the release layer is attached when sealed but the difference being the release can possibly be removed through the opening before or after sealing by die cuts 70. However, due to the reverse printing present on the remainder portion of the release, such would not be removed prior to sealing so a subsequent sealing off of said pouch area by removal of the remainder of said release layer does not seem to be in the intent of Applicant's invention. Furthermore it would create an opening directly to the sheet 570 placed in the pouch.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 25, and 27 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip in view of Kelly.

In regards to Claim 25, McKillip discloses a business form, comprising: a sheet of printable material 12 (Column 4, Lines 6 – 10; Figures 1 & 3, Item 12) having a document portion carrying documentation 24 (Column 5, Lines 41 – 44; Figure 1, Item 24), and a labeling portion where labels 22 exist (Column 5, Lines 41 – 44; Figure 1, Item 22) with the document portion being separable from the label portion (Column 5, Lines 20 – 24); a layer of adhesive material 18 positioned over the labeling portion of said sheet (Column 5, Lines 11 – 13; Figure 1, Item 18); a release layer 14 positioned over said layer of adhesive material and coextensive therewith (Column 5, Lines 11 – 13; Figure 1, Items 14 and 18 can be seen co-extensive); a label area 22 formed in said sheet in said labeling portion, said label area defining a label separable from said sheet and said release layer while retaining said adhesive material on said label (Figure 1, Items 14, 18, 22 – the figure shows the labels being peeled with the release layer staying and the adhesive going).

McKillip does not disclose a pouch area formed in said release layer, said pouch area overlying said label area and extending outwardly of the perimeter of said label area but ending short of the perimeter of said labeling portion so as to form a frame area in said release layer between the perimeter of said pouch area and the perimeter of said labeling portion; said release liner in said frame area being separable from said sheet and from the remainder of said release liner to expose said adhesive in said frame area.

McKillip does disclose an extra substrate and adhesive layer. One having ordinary skill in the art would take Official Notice that labels can be provided in one of

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two ways; one way by just having one ply of label substrate; and a second way by providing two plies of label substrates. Removal of one label ply of McKillip and only providing one label ply is within the technical grasp of one having ordinary skill in the art. Furthermore, it would have been obvious to try, by a person having ordinary skill in the art, to remove one substrate and one label layer as there are only a finite amount of label portions. One can only create dual sided labels as done in the document or, in a more simple invention, provide one substrate and adhesive in the label portion in order to provide lower manufacturing costs and save on material used or to merely provide a more simple invention.

Kelly discloses an adhesive label 30 for a carton 20 (Column 7, Lines 7 - 10) having a first die cut 60 only through said sheet and adhesive layer (Column 8, Lines 12 - 16; Figure 7, Items 30, 60) which defines a label through only said sheet and adhesive (Column 8, Lines 14 - 15) and a second die cut 58 through only said release liner outwardly the first die cut and defining in said release liner a frame around a window area (Column 8, Lines 45 - 52; Figure 7, Items 58, 60) having adhesive 52 in the perimeter (Column 8, Lines 32 - 34; Figure 6 shows adhesive being exposed in perimeter) and forming a pouch (Figure 7, Item 54; Figure 3; back side of liner forms a pouch when perimeter of adhesive is put on the box). Furthermore the release liner is obviously separable from the sheet and adhesive section considering it is a release liner. Also, considering the die cut through the liner removing the sheet of liner would leave the portion of liner with the adhesive as seen in Figure 6. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was

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made to provide the cuts of Kelly in McKillip's label substrate and liner in order to create a business form with multiple removable labels with a minimal amount of layers (Figures 6 & 7; Kelly).

With respect to the release layer in the frame area being capable of easy removal and facilitate insertion of a document into said pouch area, Kelly shows this when the release is originally separated as seen in Figure 6. With respect to allowing subsequent sealing off of said pouch area by removal of the remainder of said release layer, the Examiner is not completely sure of what is being claimed as the removal of the remainder of the release does not have an effect on the sealing since the sealing is done with the remainder of release attached (Figure 4B of Application). It is seen that the release layer is attached when sealed but the difference being the release can possibly be removed through the opening before or after sealing by die cuts 70. However, due to the reverse printing present on the remainder portion of the release, such would not be removed prior to sealing so a subsequent sealing off of said pouch area by removal of the remainder of said release layer does not seem to be in the intent of Applicant's invention.

In regards to Claim 27, McKillip modified by Kelly further discloses the upper side of said release liner inside said pouch area, together with the adhesive material exposed upon removal of said release layer in said frame area, forms a pouch for receiving documentation when said labeling portion is adhered to a container (Figure 6 shows the pouch portion behind the liner and shown adhered to an item in Figure 3; Figure 2; Kelly – nearly identical to Figure 4A filed March 23, 2007).

In regards to Claim 28, McKillip modified by Kelly further discloses said document portion is separable from said labeling portion along a line of weakness 20 (Column 5, Lines 24 – 26; Figure 1, Item 20 – Horizontal; Examiner considers it to be a line of weakness since the substrate is weakened for separation; McKillip).

In regards to Claim 29, McKillip modified by Kelly further discloses said label is formed by a die cut 60 through only said sheet and adhesive material layer (Column 8, Lines 12 – 16; Figures 4 & 7, Item 60; Kelly), and said frame is formed by a die cut 58 only through said release liner (Column 8, Lines 45 – 52; Figure 6, Item 54; Figure 7, Item 58; Kelly).

2. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKillip in view of Kelly and Gartner et al. (Gartner; U.S. 5,284,363).

In regards to Claim 26, McKillip modified by Kelly further discloses said release liner is capable substantially transparent considering it is glassine just as disclosed by applicant (Column 5, Lines 17 – 19; McKillip) wherein the liner is printable since it is disclosed it is a substrate (Column 5, Lines 11 – 20; substrates are inherently printable; once again specification states glassine is used and therefore can be printed on).

McKillip modified by Kelly does not disclose the liner has indicia printed in mirror image on its upper side so as to render said indicia legible upon removal of said label. Gartner discloses of a multiplayer label having reverse printed indicia 18 or 52 on a transparent layer so that it can be read from the other surface of the transparent layer (Column 6, Lines 7 – 20; Figure 3, Item 18; Figure 7, item 52). Therefore it would have been obvious to a person having ordinary skill at the time the invention was made to

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provide reverse printing on the pouch surface of Kelly's liner in order to provide instruction on the use of the labels of Kelly (Column 3, Lines 64 – 67 → Column 4, Line 1).

Response to Arguments

In regards to the statement that Kelly lacks a separable liner portion outside of portion 58, it is considered that the liner is removable since the label can be removed from the liner outside of portion 58. It is not clear, but it appears that Applicant is trying to state that a portion can be peeled from the liner and then a further liner area can be removed once the portion has been removed from the liner. However, Examiner notes that the claims only require that the liner be removable to create a frame. Examiner recommends clarification to the claims as to Applicant's assertions to the liner and the frame to define over the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRADEEP C. BATTULA whose telephone number is (571)272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. C. B./
Examiner, Art Unit 3725
February 17, 2009

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725